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**MAILED**

**APR 20 2010**

**OFFICE OF PETITIONS**

|                             |   |                         |
|-----------------------------|---|-------------------------|
| In re Application of        | : |                         |
| Toyomura, et al.            | : |                         |
| Application No. 09/963,569  | : | DECISION ON APPLICATION |
| Filed: September 27, 2001   | : | FOR                     |
| Atty Docket No.00862.022392 | : | PATENT TERM ADJUSTMENT  |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT AND REQUEST UNDER 37 C.F.R. § 1.705(b)," filed June 11, 2009. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from four hundred and five (405) days to one thousand, four hundred and twenty-one (1,421) days.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The Office has updated the PALM and PAIR screens to reflect that the patent term adjustment determination at the time of the mailing of the notice of allowance is **five hundred and four (504) days**. A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

On April 30, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 405 days. Applicants timely filed the instant application for patent term adjustment.<sup>1</sup>

Applicants dispute the reduction of 100 days for applicant delay in responding to the restriction/election requirement mailed September 24, 2003. Applicants explain that applicants originally submitted the reply on October 20, 2003. Applicants

<sup>1</sup> PALM finance records indicate the issue fee was paid on June 18, 2009.

indicate that a petition to withdraw the holding of abandonment was filed on April 2, 2004, accompanied by a copy of the previously filed reply and a copy of the Office date-stamped postcard whereby the Office acknowledged having received the reply on October 20, 2003. Applicants maintain that the Office construed the petition to withdraw the holding of abandonment as the reply to the restriction/election requirement and entered a period of reduction of 100 days. Applicants assert that the petition to withdraw the holding of abandonment was not reply to the restriction/election requirement and that applicants filed a reply to the restriction/election requirement on October 20, 2003, within three months of the mailing date of the restriction/election requirement. Applicants conclude that it is, therefore, improper to enter a period of reduction to the patent term adjustment of 100 days.

Applicants' argument is well taken and is supported by a review of the file record. This conclusion is not based upon applicants' argument that the Office calculated that period of reduction under 37 CFR 1.704(b) using the date the petition to withdraw the holding of abandonment was filed. Rather, it is because applicants filed a complete response within three months of the September 24, 2003, mail date of the restriction/election requirement, as evidenced by the Office date stamped postcard dated October 20, 2003. Thus, applicants did not fail to engage in reasonable efforts to conclude processing by delaying in responding to the restriction/election requirement. Accordingly, the period of reduction of 100 days is not warranted and is being removed.

It is noted that a restriction/election requirement in response to the reply received October 20, 2003, was not mailed until August 27, 2007. 37 CFR 1.703(a)(2) provides that:

The period of adjustment under § 1.702(a) is the sum of the following periods:

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing if either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, which ever occurs first[.]

Accordingly, the period of Office delay pursuant to 37 CFR 1.703(a)(2) began February 21, 2004, and ended on August 27, 2007, with the mailing of the restriction/election requirement.

Thus, the period of adjustment of 1,120 will be removed and a period of adjustment of 1,284 days will be entered for Office delay pursuant to 37 CFR 1.703(a)(2).

It is further noted that applicants dispute the reduction to the patent term adjustment of 916 days. Specifically, applicants state that:

It is also respectfully submitted that the USPTO incorrectly assessed an Applicant-delay period of 916 days for the period between the filing of the Information Disclosure Statement on October 5, 2006 and the filing of the Requested on April 2, 2004. Applicants cannot identify any failures to engage in reasonable efforts to conclude prosecution during this 916 period. The Notice of Abandonment was timely petitioned within the two months specified under 37 C.F.R. 1.181(f). Although the Decision acknowledged that the Request was filed on April 2, 2004, the Decision indicated that the Request was not received in the Office of Petitioners until the time of writing the Decision...there was no delay associated with the filing of the Information Disclosure Statement on October 5, 2006. Accordingly, it is respectfully submitted that the assessment of the 916 day period of Applicant-delay is incorrect.

*Excerpt taken from "Application for Patent Term Adjustment and Request Under 37 C.F.R. 1.705(b) to Reconsider Patent Term Adjustment", filed June 11, 2009, page 5.*

Applicants' argument has been considered but is not persuasive. A review of the application history reveals that Information Disclosure Statements were filed on May 16, 2005, June 30, 2006, and October 5, 2006, after a reply to the restriction/election requirement was filed on October 20, 2003. The record does not support a conclusion that the examiner expressly requested the filing of any of these Information Disclosure Statements. Further, a review of the above noted Information Disclosure Statements, reveals that applicants did not include a statement under 37 CFR 1.704(d).<sup>2</sup> Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

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<sup>2</sup> Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs

Accordingly, pursuant, to 37 CFR 1.704(c)(8), it is appropriate to calculate the reduction to the patent term adjustment for these filings as 574 days for the IDS filed May 16, 2005, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, May 16, 2005; 984 days for the IDS filed June 30, 2006, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, June 30, 2006, and 1,081 days for the IDS filed October 5, 2006, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, October 5, 2006. It is noted that the calendar days of the 574-day and 984-day periods of reduction overlap with the calendar days for the 1,081-days of reduction. It is appropriate, therefore, to only enter a period of reduction of 1081 days. Accordingly, the period of reduction of 916 days is being removed and the period reduction of 1,081 days is being entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is five hundred and four (504) days (1,585 (301 + 1,284) days of Office delay - 1,081 days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) was received on June 11, 2009. No additional fees are required.


Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

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accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

A handwritten signature in black ink, appearing to read 'Anthony Knight', with a stylized flourish at the end.

Anthony Knight  
Director  
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Monday  
Date: 4/19/2010

# PALM INTRANET

Time: 15:35:02

## PTA Calculations for Application: 09/963569

|                          |            |                         |      |
|--------------------------|------------|-------------------------|------|
| Application Filing Date: | 09/27/2001 | PTO Delay (PTO):        | 1421 |
| Issue Date of Patent:    |            | Three Years:            | 0    |
| Pre-Issue Petitions:     | 0          | Applicant Delay (APPL): | 1016 |
| Post-Issue Petitions:    | 0          | Total PTA (days):       | 504  |
| PTO Delay Adjustment:    | 99         |                         |      |

## File Contents History

| Number | Date       | Contents Description                               | PTO | APPL | START |
|--------|------------|--|-----|------|-------|
| 89     | 04/19/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO               | 99  |      |       |
| 77     | 05/12/2009 | MAIL NOTICE OF ALLOWANCE                           |     |      |       |
| 76     | 04/28/2008 | ISSUE REVISION COMPLETED                           |     |      |       |
| 75     | 04/28/2009 | DOCUMENT VERIFICATION                              |     |      |       |
| 74     | 05/12/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED    |     |      |       |
| 73     | 05/12/2009 | NOTICE OF ALLOWABILITY                             |     |      |       |
| 72     | 05/12/2009 | DATE FORWARDED TO EXAMINER                         |     |      |       |
| 71     | 04/13/2009 | SUPPLEMENTAL RESPONSE                              |     |      |       |
| 65     | 04/28/2009 | CASE DOCKETED TO EXAMINER IN GAU                   |     |      |       |
| 63     | 03/11/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED        |     |      |       |
| 62     | 04/13/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED        |     |      |       |
| 61     | 04/13/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED       |     |      |       |
| 60     | 03/31/2009 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)       |     |      |       |
| 59     | 03/26/2009 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)     |     |      |       |
| 58     | 03/11/2009 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT        |     |      |       |
| 57     | 03/18/2009 | DATE FORWARDED TO EXAMINER                         |     |      |       |
| 56     | 03/11/2009 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE |     |      |       |
| 55     | 03/18/2009 | DATE FORWARDED TO EXAMINER                         |     |      |       |
| 54     | 03/11/2009 | REQUEST FOR CONTINUED EXAMINATION (RCE)            |     |      |       |
|        |            |  |     |      |       |

|      |            |  |      |     |    |
|------|------------|--|------|-----|----|
| 53   | 03/18/2009 | DISPOSAL FOR A RCE / CPA / R129              |      |     |    |
| 52   | 03/11/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED |      |     |    |
| 51   | 03/11/2009 | WORKFLOW - REQUEST FOR RCE - BEGIN           |      |     |    |
| 50   | 12/11/2008 | MAIL FINAL REJECTION (PTOL - 326)            |      |     |    |
| 49   | 12/08/2008 | FINAL REJECTION                              |      |     |    |
| 48   | 09/28/2008 | DATE FORWARDED TO EXAMINER                   |      |     |    |
| 47   | 09/03/2008 | RESPONSE AFTER NON-FINAL ACTION              |      |     |    |
| 46   | 06/03/2008 | MAIL NON-FINAL REJECTION                     |      |     |    |
| 45   | 05/30/2008 | NON-FINAL REJECTION                          |      |     |    |
| 44   | 04/09/2008 | DATE FORWARDED TO EXAMINER                   |      |     |    |
| 43   | 02/19/2008 | RESPONSE AFTER EX PARTE QUAYLE ACTION        |      |     |    |
| 42   | 01/28/2008 | MAIL EX PARTE QUAYLE ACTION (PTOL - 326)     |      |     |    |
| 41   | 01/22/2008 | EX PARTE QUAYLE ACTION                       |      |     |    |
| 36   | 11/15/2007 | DATE FORWARDED TO EXAMINER                   |      |     |    |
| 35   | 11/01/2007 | RESPONSE TO ELECTION / RESTRICTION FILED     |      |     |    |
| 34   | 11/01/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED      |      |     |    |
| 33   | 08/27/2007 | MAIL RESTRICTION REQUIREMENT                 | 1120 |     | 30 |
| 32   | 08/20/2007 | REQUIREMENT FOR RESTRICTION / ELECTION       |      |     |    |
| 31   | 07/19/2007 | DATE FORWARDED TO EXAMINER                   |      |     |    |
| 30   | 04/02/2004 | RESPONSE TO ELECTION / RESTRICTION FILED     |      | 100 | 15 |
| 29   | 07/20/2007 | MAIL NOTICE OF RESCINDED ABANDONMENT         |      |     |    |
| 28   | 06/30/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED  |      |     |    |
| 27   | 06/30/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED |      |     |    |
| 26   | 07/06/2007 | NOTICE OF RESCINDED ABANDONMENT IN TCS       |      |     |    |
| 25   | 10/05/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED  |      |     |    |
| 24   | 10/05/2006 | REFERENCE CAPTURE ON IDS                     |      |     |    |
| 23.7 | 10/05/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED |      | 916 | 30 |
| 23   | 10/05/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED |      |     |    |
| 22   | 07/13/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE   |      |     |    |
| 21   | 06/19/2006 | MAIL-PETITION TO REVIVE APPLICATION -        |      |     |    |

|      |            |  |     |  |    |
|------|------------|--|-----|--|----|
|      |            | GRANTED  |     |  |    |
| 20   | 04/02/2004 | PETITION ENTERED   |     |  |    |
| 19   | 05/16/2005 | REFERENCE CAPTURE ON IDS                                       |     |  |    |
| 18.7 | 05/16/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 18   | 05/16/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 17   | 03/15/2004 | MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION       |     |  |    |
| 16   | 03/08/2004 | ABAND. FOR FAILURE TO RESPOND TO O. A.                         |     |  |    |
| 15   | 09/24/2003 | MAIL RESTRICTION REQUIREMENT                                   | 301 |  | -1 |
| 14   | 09/22/2003 | REQUIREMENT FOR RESTRICTION / ELECTION                         |     |  |    |
| 13.7 | 01/29/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 13   | 01/29/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 12   | 07/30/2002 | CASE DOCKETED TO EXAMINER IN GAU                               |     |  |    |
| 11   | 01/08/2002 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) |     |  |    |
| 10.7 | 01/08/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 10   | 01/08/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 9.7  | 12/27/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 9    | 12/27/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED                   |     |  |    |
| 8    | 06/12/2002 | CASE DOCKETED TO EXAMINER IN GAU                               |     |  |    |
| 7    | 01/04/2002 | APPLICATION DISPATCHED FROM OIPE                               |     |  |    |
| 6    | 01/04/2002 | APPLICATION IS NOW COMPLETE                                    |     |  |    |
| 5    | 10/26/2001 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED    |     |  |    |
| 3    | 10/24/2001 | CORRESPONDENCE ADDRESS CHANGE                                  |     |  |    |
| 2    | 10/02/2001 | IFW SCAN & PACR AUTO SECURITY REVIEW                           |     |  |    |
| 1    | 09/27/2001 | INITIAL EXAM TEAM NN   |     |  |    |

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION



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